

Appl. No. 09/872,668

Atty. Docket No. 10008156-1

**REMARKS**

This application has been carefully reviewed in light of the Office Action dated November 3, 2004. By way of this amendment, claims 1 and 9 have been amended. Claims 1-14 are currently pending in the application. Applicant hereby requests further examination and reconsideration in view of the following remarks.

The Examiner has rejected claims 1-14 under 35 U.S.C. § 103(a) as being unpatentable over Castle. This ground of rejection is respectfully traversed.

Castle discloses a method and apparatus maximizing advertising revenue in which electronic copies of advertisements are stored in a pool. Advertisements from the pool can then be matched to publications such as electronic or online versions of newspapers or periodicals or online publication services like the Hewlett-Packard Instant Delivery™ service (HPID).

Applicant respectfully submits that Castle fails to render independent claim 1 obvious for numerous reasons. First, claim 1 recites a method for targeting advertisements into media on demand selected from a media selection interface. Castle does not involve media on demand but instead applies to electronic publications like online newspapers or online publication services. While Castle mentions that such services may provide content of general interest to a particular subscriber, there is no indication that Castle contemplates a media on demand service wherein a user is able to make a request for a specific piece of media.

Second, claim 1 recites the steps of "determining a set of advertisement space information from said electronic copy of said media request for at least one advertisement space in said media request" and "communicating said set of advertisement space information to at least one advertising provider to solicit bidding on said at least one advertising space from said at least one

advertising provider." In other words, a specific advertising space in a specific media item is communicated to the advertising provider so that the advertising provider can bid on that specific advertising space. Castle does not suggest this claimed feature. Instead, in Castle, advertisements are first placed in a pool 110 for later retrieval (see paragraph 0012). Advertisements are then subsequently selected from the pool for placement in publications. While Castle does indicate that the advertisements in the pool can be matched or fitted to conform to each subscriber to whom the electronic publication is to be delivered (paragraph 0016), there is no disclosure in Castle of the advertiser placing an advertisement into a specific media item. The advertiser is only able to place advertisements into a pool with the hope that the advertisements will be placed in relevant publications.

Third, claim 1 recites the steps of "querying said at least one advertising provider for an electronic copy of an advertisement for said advertisement space associated with said winning bid" and "receiving said electronic copy of said advertisement in response to querying said at least one advertising provider for an electronic copy of an advertisement." That is, the advertising provider is requested to supply an electronic copy of the advertisement after the provider's bid is chosen as the winner. In Castle, the advertisements have been previously placed in the pool at the time that advertisements are selected for inclusion in a publication. Thus, Castle does not query advertising providers for electronic copies of an advertisement after it is selected because the electronic copies of all pooled advertisements are already stored in the system and thus available. And while Castle does receive electronic copies of advertisements, it does not receive such electronic copies in response to querying the advertising providers for advertisements associated with a winning bid.

Lastly, the Examiner states that it would have been obvious to "modify and interpret the disclosure of Castle" as implicitly showing certain limitations of claim 1 "because modification and interpretation of the cited disclosure of Castle would have provided '*a method and apparatus for automatically auctioning advertising space at market rates to prospective advertisers in an on-line publication....*' " Applicant respectfully disagrees with this position. The examiner seems to be arguing that it would have been obvious to modify and interpret Castle in a particular manner because to do so would provide a method and apparatus for automatically auctioning advertising space at market rates to prospective advertisers in an on-line publication. However, why would Castle need to be modified and interpreted to provide a method and apparatus for automatically auctioning advertising space when the reference already purports in paragraph 0006 to provide just such a method and apparatus? There is no reason to modify or interpret Castle to provide a method and apparatus for automatically auctioning advertising space because Castle already provides such a method and apparatus. It is submitted that the Examiner's reasoning cannot valid because, if it were, then any invention for a method and apparatus for automatically auctioning advertising space at market rates to prospective advertisers in an on-line publication, no matter how unique and different from Castle, would be obvious. The true basis for modifying a reference is whether there is some teaching or suggestion in the prior art to do so. Here, there is no suggestion in the prior art to modify Castle in the manner set forth by the Examiner, and the purposed interpretation relies on impermissible hindsight.

For the above reasons, it is respectfully submitted that independent claim 1 is allowable over Castle. Claims 2-8 depend from claim 1 and are thus also believed to be allowable. Furthermore, at least some of these dependent claims set forth limitations not met by the prior art. For instance, with respect to

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each of claims 2-8, the Examiner repeats the argument that it would have been obvious to "modify and interpret the disclosure of Castle" as implicitly showing certain limitations of claim 1 "because modification and interpretation of the cited disclosure of Castle would have provided '*a method and apparatus for automatically auctioning advertising space at market rates to prospective advertisers in an on-line publication....*' " Applicant respectfully submits that this rationale is in error with respect to claims 2-8 for the same reasons described above in connection with claim 1.

Also, it is noted that the Examiner takes "Official Notice" that certain recitations in claims 5 and 7 were "well known and expected in the art." However, MPEP §2144.03 states that "It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known." In this case, it is submitted that the recitations of "determining the dimensions of said advertisement space" and "determining the location of said advertisement space in said media request" from claim 5 and the recitations of "a unique identification number for each available advertisement space" and "a set of dimensions for each available advertisement space" from claim 7 are not capable of instant and unquestionable demonstration as being well-known. Applicant therefore traverses the assertion that these claimed features are old and well known and requests that the Examiner cite a reference in support of this position as required by MPEP §2144.03.

Regarding independent claim 9, the Examiner states that this claim is rejected for substantially the same reasons as independent claim 1. Applicant respectfully submits that Castle fails to render independent claim 9 obvious for same reasons given above in connection with claim 1. Furthermore, claim 9 recites additional features not suggested by Castle such as "displaying a list of

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available media on said display device of said media selection interface" and "accessing an operational program accessible to said service provider for comparing said received bids for each available advertising space in said media request and choosing a winning bid for each available advertising space in said media request." For these reasons, applicant requests that the rejection of claim 9 be withdrawn.

Regarding independent claim 10, applicant submits that Castle does not suggest the claimed limitation of receiving a set of advertisement space information that includes a unique identification number, a set of dimensions, and a location for each available advertisement space in a media request. Castle also does not disclose assigning a value to each available advertisement space based upon the set of advertisement space information and the user profile. While Castle does teach providing prospective advertisers with subscriber demographic data (see paragraph 0014), this only provides the prospective advertisers "some assurance" that their advertisements will be delivered to preferred recipients. In Castle, advertisers are not able to use subscriber information to assign a value to a particular advertisement space because they only submit ads into a pool for selection by the publisher. Advertisers in Castle do not bid on specific advertisement spaces.

The Examiner re-applies the argument that it would have been obvious to "modify and interpret the disclosure of Castle" as implicitly showing certain limitations of claim 10 "because modification and interpretation of the cited disclosure of Castle would have provided '*a method and apparatus for automatically auctioning advertising space at market rates to prospective advertisers in an on-line publication....*' " Again, applicant respectfully submits that this rationale is in error with respect to claim 10 for the same reasons described above in connection with claim 1.

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Also, the Examiner again takes "Official Notice" that numerous recitations in claim 10 were "well known and expected in the art." Applicant respectfully submits that the claim 10 recitations are not capable of instant and unquestionable demonstration as being well-known. Applicant therefore traverses the assertion that these claimed features are old and well known and requests that the Examiner cite a reference in support of this position as required by MPEP §2144.03.

For the above reasons, it is respectfully submitted that independent claim 10 is allowable over Castle. Claims 11 and 12 depend from claim 10 and are thus also believed to be allowable. Furthermore, these dependent claims set forth limitations not met by the prior art.

Regarding independent claim 13, the Examiner states that this claim is rejected for substantially the same reasons as independent claim 1. Applicant respectfully submits that Castle fails to render independent claim 13 obvious for many of the reasons given above in connection with claim 1. Furthermore, Castle does not suggest the claim 13 limitation of "at least one operational program for receiving said set of user information, querying said at least one advertisement database for corresponding user information and determining a bid amount for said advertisement data associated with said user information." Castle does not teach determining a bid amount based on user information because, as discussed above, advertisers in Castle merely submit ads into a pool and do not bid on specific advertisement spaces.

Therefore, it is respectfully submitted that independent claim 13 is allowable over Castle. Claim 14 depends from claim 13 and is thus also believed to be allowable. Furthermore, the Examiner takes "Official Notice" that the recitations of claim 14 were "well known and expected in the art." Applicant respectfully submits that the claim 14 recitations are not capable of instant and unquestionable demonstration as being well-known. Applicant therefore

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traverses the assertion that these claimed features are old and well known and requests that the Examiner cite a reference in support of this position as required by MPEP §2144.03.

In view of the above, it is submitted that the claims are in condition for allowance. Reconsideration of the objections and rejections is requested. Allowance of claims 1-14 at an early date is solicited.

Respectfully submitted,

2/3/05

Date

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